

REMARKS

This Response is submitted in reply to the Office Action dated October 9, 2008, and in accordance with the telephone interview courteously granted to Applicant's representative on October 8, 2008 and the personal interview courteously granted to Applicant's representatives on December 9, 2008. Applicant has amended claims 1, 4, 10, 11, 14, 20, 21, and 31. Applicant has cancelled Claim 25 without prejudice or disclaimer. Applicant has added new Claims 32 to 37. No new matter is added by these amendments or these new claims. A Petition for a One-Month Extension of Time to respond to the Office Action is submitted herewith. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Response.

The Office Action rejected Claims 1 to 4, 9 to 14, 19 to 25, and 30 to 31 under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 5,393,057 to Marnell ("Marnell") in view of U.S. Patent No. 6,739,971 to Devaull ("Devaull"). Applicant respectfully disagrees with and traverses these rejections. Nonetheless, to advance prosecution, Applicant has amended certain of the claims for clarity.

Marnell discloses an electronic gaming apparatus which includes:

a display and input buttons for play of a primary game, such as a poker game; and electronic secondary gaming device, such as a bingo-type gaming device, including a display, such as a bingo matrix having a plurality of spaces. The poker gaming device and the bingo-type gaming device are electrically connected together. In one embodiment of the invention, the bingo matrix spaces are filled by a random generator device with indicia related to the primary gaming device. When predetermined results occur in the primary game, such as a poker hand or slot machine set of reels, these results are automatically entered in the secondary game.

Marnell discloses that the secondary game includes "game simulations which are based upon, connected with, or derived from, a conventional bingo game." Marnell, column 5, lines 29 and 30. If a poker hand of the primary game of Marnell meets the poker game criteria for a winning hand, the occurrence of the winning hand "either enables or automatically produces an entry into bingo matrix 51, if the bingo matrix also includes the winning hand." Marnell, column 5, lines 65 to 68. If the bingo matrix

includes duplicate indicia representing the winning poker hand, Marnell discloses that a random computer selection or user selection could be made as between duplicates. See Marnell, column 5, lines 51 to 60. In Marnell, the player "may continue to play poker gaming apparatus 22 until a BINGO is achieved in bingo gaming apparatus 23, at which point game apparatus 21 will award money, awards or benefits for winning the bingo game." Marnell, column 6, lines 18 to 22.

The method of operating a gaming system of amended independent Claim 1 includes, among other elements: (a) accepting a wager from a player using at least one input device, (b) presenting a play of a main game including randomly generating and causing at least one display device to display at least a first set of cards to generate a main game hand, (c) determining an outcome of the play of the main game comprising comparing the main game hand to a set of different predetermined winning hands, (d) if the main game hand is one of the predetermined winning hands, awarding the player a winning amount and determining if the winning hand corresponds to any corresponding one of a plurality of different predetermined bonus categories and, if so, associating a value greater than zero with the corresponding bonus category, (e) enabling the player to cause a play of a bonus event if a bonus condition occurs, the bonus condition occurring when a designated number of values is associated with a designated number of the predetermined bonus categories, the designated number of values being at least one, and the designated number of the predetermined bonus categories being at least one, (f) repeating (a) through (e) until the player causes the play of the bonus event, and (g) if the player causes the play of the bonus event, causing the at least one display device to display the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game, and if any value is associated with the at least one selected bonus category, awarding a bonus win according to the associated value.

Page 4 of the Office Action acknowledges that Marnell is "silent regarding teaching enabling a player input subsequent to the determination of the game result wherein the player input is independent of the game result and causes play of a bonus

event". Devaull discloses a game of chance including a bonus accumulator which accumulates bonus elements based on a predetermined criteria. See Devaull, column 2, lines 14 to 16. The bonus elements "are redeemable by a player for an award during any game play cycle defined as starting with the wager and ending with a succeeding wager triggering the game play engine." Devaull, column 2, lines 16 to 19. The Office Action states that Devaull "teaches enabling the player to provide a game input to cause play of the bonus game prior during and subsequent to the determination of a game result". The Office Action concludes that it would have been obvious to one skilled in the art to have incorporated "the selective redemption feature of Devaull in the invention of Marnell because such a combination of wild symbols and symbol categories would have represented the use of known gaming features combined in conventional manners to yield predictable results."

Applicant respectfully disagrees and submits that the Office Action improperly relies on hindsight reasoning as a justification for this obviousness rejection. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. When the Examiner fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been made in hindsight, which is improper. That is, even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. The notion that claims can be deemed obvious merely upon finding similar elements in separate prior parts would necessarily destroy virtually all patents and defeat the congressional purpose in enacting Title 35. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to form the claimed invention.

In this case, the Office Action improperly uses hindsight reasoning by failing to explain why one skilled in the art would have been specifically motivated to incorporate the selective redemption feature of Devaull into the poker primary game and bingo-type

bonus game of Marnell. The Office Action's statement that "such a combination of wild symbols and symbol categories would have represented the use of known gaming features combined in conventional manners to yield predictable results" is insufficient because combining "wild symbols" and "symbol categories" appears to have no relation to the selective redemption feature of Devaull and why one skilled in the art would have been specifically motivated to incorporate the selective redemption feature of Devaull into the poker primary game and bingo-type secondary game of Marnell. Although Devaull discloses redeeming bonus elements for wild cards for use in the primary poker game of Devaull, amended independent Claim 1 is not directed to a method of operating a gaming system which includes this element. Therefore, because the Office Action fails to explain how the skilled artisan would have been specifically motivated by Marnell and Devaull to arrive at the method of operating a gaming system of amended independent Claim 1, the obviousness determination appears to have been made in hindsight, which is improper. If the Examiner disagrees, Applicant respectfully requests that the Examiner specifically point out, with references to the cited art, which elements of Marnell and Devaull the Examiner considers to be the "wild symbols" and "symbol categories", and explain how the Examiner considers the combination of these elements to anticipate amended independent Claim 1.

Furthermore, as best understood by Applicant, the Office Action appears to propose incorporating into Marnell the Devaull feature of enabling a player to provide a game input to cause play of the bonus game prior, during, and subsequent to the determination of a game result to enable the player of the combined gaming device to provide a game input to cause play of the bonus game prior, during, and subsequent to the determination of a game result. That is, the Office Action appears to propose modifying the Marnell gaming device to enable the player to provide a game input to cause play of the Marnell bonus game prior to and during the determination of a primary game outcome (i.e., mid-stream). However, Section 2143 of the MPEP states that if "the proposed modification or combination of the prior art would change the principal of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (citing *In re Ratti*, 270 F.2d,

810). Applicant submits that the Office Action's apparent proposed combination of Marnell and Devaull would change the principle of operation of Marnell, and therefore the teachings of Marnell and Devaull are insufficient to render amended independent Claim 1 *prima facie* obvious.

In Marnell, if a poker hand of the primary game of Marnell meets the poker game criteria for a winning hand, the occurrence of the winning hand "either enables or automatically produces an entry into bingo matrix 51, if the bingo matrix also includes the winning hand." Marnell, column 5, lines 65 to 68. Accordingly, the player of the Marnell gaming device plays the bonus game only after the Marnell gaming device determines an outcome of the primary game, and only if the outcome of the primary game is a winning outcome. The player of the Marnell gaming device does not appear to provide a game input to cause play the bonus event mid-stream because Marnell requires a winning hand in the primary game to compare to the poker hands of the bingo matrix so that the Marnell gaming device can: (i) determine whether to produce an entry into the bingo matrix, and (ii) determine which bingo matrix space to produce the entry into. If the player of the Marnell gaming device could provide a game input to cause play of the secondary bingo game of Marnell mid-stream (i.e., prior to or during the determination of whether the poker hand of the primary game of Marnell is a winning hand), the Marnell gaming device would not have a winning hand of the primary game to compare to the poker hands of the bingo matrix to determine whether to produce an entry into the bingo matrix, and which bingo matrix space to produce the entry into. That is, because the bingo-type secondary game of Marnell requires a primary game outcome in order to play the secondary game, if the player causes play of the bingo-type secondary game of Marnell prior to or during the determination of the primary game outcome (i.e., before the primary game outcome exists), play of the secondary game of Marnell would be impossible. Thus, enabling the player of the Marnell Gaming device to provide a game input to cause play of the bingo-type secondary game of Marnell would change the basic principle of operation of Marnell.

Therefore, the Office Action's proposed combination of Marnell and Devaull would require a substantial reconstruction and redesign of the elements (particularly the

bingo secondary game) of Marnell to enable the Marnell gaming device to determine whether to produce an entry into the bingo matrix and which bingo matrix space the Marnell gaming device should produce the entry into. Specifically, enabling the player of the Marnell gaming device to provide a game input to cause play of the Marnell bonus game mid-stream would require that the Marnell bonus game determine whether to produce an entry into the bingo matrix and which bingo matrix space to produce the entry into based on some criteria other than the outcome of the primary game. This substantial reconstruction and redesign of Marnell would change (if not destroy entirely) the basic principle of operation of the bingo-type secondary game of Marnell. Accordingly, the teachings of Marnell and Devaull are insufficient to render amended independent Claim 1 *prima facie* obvious.

Furthermore, as discussed during the personal interview, Applicant submits that even if Marnell is modified to include the Devaull feature of enabling the player to provide a game input to cause play of the bonus game prior, during and subsequent to the determination of a game result, the method resulting from the combination of these references does not disclose or render obvious a method of operating a gaming system which includes causing the at least one display device to display the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game, and if any value is associated with the at least one selected bonus category, awarding a bonus win according to the associated value.

In Marnell, if a poker hand of the primary game of Marnell meets the poker game criteria for a winning hand, the occurrence of the winning hand "either enables or automatically produces an entry into bingo matrix 51, if the bingo matrix also includes the winning hand." Marnell, column 5, lines 65 to 68. If the bingo matrix includes duplicate indicia representing the winning poker hand, Marnell discloses that a random computer selection or user selection could be made as between duplicates. Marnell, column 5, lines 57 to 60. However, even if Marnell randomly selects one of the duplicate bingo matrix spaces, the random selection of Marnell is clearly dependent on

the outcome of the primary game because Marnell requires a winning hand in the primary game to determine which of the bingo matrix spaces to select between. That is, under the Office Action's interpretation of Marnell, play of the secondary bingo game of Marnell (and any random selection of bonus categories in Marnell) is dependent on (and results from) the outcome of the primary game of Marnell. Therefore, Marnell does not disclose randomly selecting at least one of the bonus categories, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game.

Devauil does not cure the deficiencies of Marnell. As discussed above, the Office Action acknowledges that Marnell is "silent regarding teaching enabling a player input subsequent to the determination of the game result wherein the player input is independent of the game result and causes play of a bonus event". (Emphasis Added). The Office Action relies on Devauil for disclosure of "enabling the player to provide a game input to cause play of the bonus game prior during and subsequent to the determination of a game result". Devauil discloses enabling the player to redeem bonus elements "for an award during any gameplay cycle." Devauil, column 5, lines 14 to 15. Devauil also discloses that in one embodiment, "the award is in the form of free plays of the bonus game depicted in Fig. 4." Devauil, column 5, lines 44 to 45. However, even if Devauil discloses that the player input which causes play of a bonus event is independent of the game result, Devauil does not disclose randomly selecting a bonus category, the random selection of the bonus category being in addition to and independent of any previously displayed play of the main game.

Additionally, Applicant respectfully submits that the Office Action relies on certain sections of Marnell which are directed to multi-player embodiments of Marnell. For example, page 4 of the Office Action relies on column 10, lines 7 to 24 for disclosure of "playing the bonus event concurrently with the play of the main game wherein based on the random selection of winning hands across a plurality of categories of said bonus event a bonus is awarded reflective of the categories randomly selected." However, the passage of Marnell relied upon by the Office Action states:

Upon play of the bingo game by multiple players, and upon the occurrence of filling of spaces 52, 52a, 52b in matrix 51, 51a, 51b which meets the

bingo criteria of memory 71, the bingo game will be deemed to be complete. Bingo microprocessor 69 can weight the proportion of the amount to be paid out, for example, progressive jackpot number 49, 49a, 49b, among the weighted input in the winning bingo row. Thus, in the "bingo" of FIG. 3, station one, with four-of-a-kind, would receive a greater proportion of the progressive bingo jackpot than would station 12, which had input two pair. The bingo master microprocessor 69 would then provide a signal back to the individual machines, namely, machines 21₁, 21₂, 21₃, 21₇ and 21₁₂, indicating the amount of money, or other award, that each player had won. Master bingo microprocessor 69 would then clear the winning row or possibly the entire bingo matrix. (Emphasis added).

Accordingly, this section is directed to a multi-player embodiment of Marnell.

Therefore, unlike the method of operating a gaming system of amended independent Claim 1, Marnell and Devaull, alone or in combination, do not disclose or render obvious causing the at least one display device to display the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Marnell in view of Devaull to result in such method of operating a gaming system without reasonably being construed as improper hindsight reconstruction.

For at least these reasons, amended independent Claim 1 is patently distinguished over the cited references and is in condition for allowance. Claims 2 to 4, and 9 to 10 depend directly or indirectly from amended independent Claim 1 and are allowable for similar reasons, and because of the additional features recited in these claims.

Amended independent Claims 11 and 21 include similar elements as amended independent Claim 1 and are allowable for similar reasons. Claims 12 to 14, and 19 and 20, and Claims 22 to 25, and 30 to 31 depend directly and indirectly from amended independent Claims 11 and 21, respectively, and are allowable for similar reasons, and because of the additional features recited in these claims.

The Office Action rejected Claims 5 to 8, 15 to 18, and 26 to 29 under 35 U.S.C § 103(a) as being anticipated by Marnell in view of Devaull, and further in view of U.S. Patent No. 6,419,579 to Bennett ("Bennett"). Applicant respectfully disagrees with and traverses these rejections. Nonetheless, to advance prosecution, Applicant has amended certain of the claims for clarity.

As described above, Marnell discloses an electronic gaming apparatus which includes a primary game and a secondary game, such as a bingo-type game. If a poker hand of the primary game meets the poker game criteria for a winning hand, the occurrence of the winning hand either enables or automatically produces an entry into the bingo matrix, if the bingo matrix also includes the winning hand. Bennett discloses a bonus event wherein a symbol, such as one or more dice, is displayed to indicate a multiplier, which is used in combination with a value generated in a main game to determine an additional payout amount.

Page 6 of the Office Action states that Marnell is "silent regarding the utilization of two dice to determine a multiplier utilized in combination with a bonus winning to determine an additional payout amount or equivalently described as a score." The Office Action further states that "it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the utilization of dice to determine a supplemental prize multiplier as taught by Bennett into the invention of Marnell in order to maintain a player interest in a gaming machine as taught by Bennett". Applicant respectfully disagrees and submits that regardless of whether it would have been obvious to incorporate the utilization of dice to determine a supplemental prize multiplier into Marnell and Devaull, unlike the methods of operating a gaming system of Claims 5 to 8, 15 to 18, and 26 to 29, neither Marnell, Devaull, nor Bennett, alone or in combination, disclose or render obvious causing the at least one display device to display the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game, and if any value is associated with the at least one selected bonus category, awarding a bonus win according to the associated value. Moreover, it

would not have been obvious to one of ordinary skill in the art to modify Marnell in view of Devaull, and further in view of Bennett to result in such methods of operating a gaming system without reasonably being construed as improper hindsight reconstruction.

For at least these reasons, and because of the additional features recited in these claims, Claims 5 to 8, 15 to 18, and 26 to 29 are patently distinguished over Marnell in combination with Devaull and Bennett, and are in condition for allowance.

New Claims 32 to 37 are supported in the specification at least in paragraphs [0015] and [0017] of the specification. New Claims 32 to 33, Claims 34 to 35, and Claims 36 to 37 depend directly or indirectly from amended independent Claims 1, 11, and 21, respectively, and are allowable for similar reasons as given above with respect to these amended independent claims, and because of the additional features recited in these new claims.

An earnest endeavor has been made to place this application in condition for formal allowance, which is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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